

REMARKS

A. Status of Claims.

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1 and 4–17 are pending. In this Request for Reconsideration, claims 6, 8, 13 and 15 are amended. No new matter is added.

B. Support for Amendments to Claims.

Support for the amendment to claims 6, 8, 13 and 15 is found in the specification at page 4, paragraph 22, in FIGS. 1A and 1B, as well as elsewhere in the originally filed specification, drawings, and claims.

C. Rejection of Claims 6, 8, 13 and 15, under 35 U.S.C. § 112, ¶2.

Claims 6, 8, 13 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is regarded as the invention.

These claims have been amended to correct typographical errors. Because these claims now comply with 35 U.S.C. § 112, second paragraph, applicant respectfully requests that this rejection be withdrawn.

D. Response to Rejections of Claims 1, 4–6, 8, 10–13, 15 and 17, under 35 U.S.C. § 103(a) as being Unpatentable over Asum in view of Blank.

a. Rejection of Claims 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank.

Claims 1, 4–6, 8, 10–13, 15 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,836,810 to Asum in view of U.S. Patent No. 6,386,873 to Blank.

b. The Final Office Action Does Not Properly Allege a *Prima Facie* Case of Obviousness under MPEP § 706.02(j) in Combining Asum with Blank.

i. Requirements to establish a *prima facie* case of obviousness under MPEP § 706.02(j).

This rejection is *prima facie* improper, because the Final Office Action provides no proper basis for combining Asum with Blank. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143- §2143.03 for decisions pertinent to each of these criteria (emphasis added).” For at least the following reasons, the Final Office Action has erroneously failed to comply with the above requirements of MPEP § 706.02(j).

ii. This rejection provides no proper motivation for combining Asum with Blank.

As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific

reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

The Final Office Action attempts to justify combining Asum and Blank based on the following allegation:

(1) It would be obvious to one of ordinary skill in the art to modify Asum to include abrasive on both sides as taught by Blank in order to deliver the abrasive action to the desired locations. (See Final Office Action, p. 3)

Allegation 1 is completely unsupported by any factual evidence provided by the Final Office Action. In addition, and contrary to controlling Federal Circuit precedent (see Federal Circuit cases cited above), Allegation fails to identify any portion of Asum that would properly provide a person of ordinary skill in the art reading Asum with motivation to look for Blank. The Final Office Action also fails to cite any text from Asum, Blank, or any other reference in support of the allegation that shows that a person of ordinary skill in the art would be motivated to combine Asum with Blank. In fact, the Final Office Action has failed to even address the issue of “motivation” with respect to the combinations of Asum and Blank. Because the Final Office Action has failed to provide a proper motivation for combining Asum with Blank, the rejection of Claims 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank is *prima facie* improper.

iii. The rejection of 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank is based on an improper hindsight use of Applicant’s own disclosure.

The alleged basis for combining Asum with Blank set forth in the Final Office Action in Allegation (1), quoted above, presupposes the combination of Asum with Blank and then provides a hindsight justification for this combination. But for reading Applicant’s application, a person of ordinary skill in the art would have no reason to combine Asum with Blank. Such reliance on Applicant’s application to combine the cited

references is impermissible according to controlling Federal Circuit precedent. As the Federal Circuit stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that “Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 [42 USPQ2d 1378] (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).” Therefore, based on controlling Federal Circuit precedent, the rejection of Claims 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank is *prima facie* improper, because the rejection is based on improper hindsight.

iv. Because the Rejection of Claims 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank is *Prima Facie* Improper, this Rejection Should Be Withdrawn.

For at least the reasons discussed above, the combination of Asum and Blank is *prima facie* improper according to both MPEP § 706.02(j) and controlling Federal Circuit case law. Therefore, the rejection of Claims 1, 4–6, 8, 10–13, 15 and 17 over Asum in view of Blank is *prima facie* improper and should be withdrawn.

E. Response to Rejections of Claims 7, 9, 14 and 16, under 35 U.S.C. § 103(a) as being Unpatentable over Asum in view of Blank and further in view of Kyotani.

a. Rejection of Claims 7, 9, 14 and 16 under 35 U.S.C. § 103(a).

Claims 7, 9, 14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,836,810 to Asum in view of U.S. Patent No. 6,386,873 to Blank in further view of U.S. Patent No. 4,690,642 to Kyotani.

b. The Final Office Action Does Not Properly Allege a *Prima Facie* Case of Obviousness under MPEP § 706.02(j) in Combining Kyotani with Asum and Blank.

i. Requirements to establish a *prima facie* case of obviousness under MPEP § 706.02(j).

This rejection is *prima facie* improper, because the Final Office Action provides no proper basis for combining Asum with Blank and further in view of Kyotani. See quotations from MPEP § 706.02(j) in section (D)(c)(i) above.

ii. This rejection provides no proper motivation for combining Kyotani with Asum and Blank.

As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

The Final Office Action attempts to justify combining Asum with Blank and further in view of Kyotani based on the following allegation:

(2) The above combination¹ teaches using different abrasives and using

¹ Referring to the Examiner’s combination of Asum and Blank.

abrasives on both sides, however, the above combination does not show using different abrasives on both sides. It would be obvious to one of ordinary skill in the art to modify the above combination to include using different abrasives on different sides as shown by Kyotani in order to apply the desired degree of abrasives to the desired locations. (See Final Office Action, p. 3)

Allegation (2) is completely unsupported by any factual evidence provided by the Final Office Action. In addition, and contrary to controlling Federal Circuit precedent (see Federal Circuit cases cited above), Allegation (2) fails to cite any portion of Asum, Blank, Kyotani, or any other reference in support of the allegation that a person of ordinary skill in the art would be motivated to combine Kyotani with Blank and Asum. The Final Office Action not only fails to identify any text in Blank and/or Asum that would suggest that a person of ordinary skill in the art reading Asum and/or Blank should read Kyotani, but also fails to identify any portion of Kyotani that suggests that a person reading Kyotani should look at Blank and/or Asum. Because the Final Office Action has not articulated a proper basis for combining Kyotani with Blank and Asum, the rejection of Claims 7, 9, 14 and 16 over Asum in view of Blank is *prima facie* improper.

iii. The rejection of claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani is based on an improper hindsight use of Applicant's own disclosure.

The alleged basis for combining Asum with Blank and Kyotani set forth in the Final Office Action in Allegation (2), quoted above, presupposes the combination of Asum with Blank, and then provides a hindsight justification for this combination. But for reading Applicant's application, a person of ordinary skill in the art would have no reason to combine Asum with Blank. Such reliance on Applicant's application to combine the cited references is impermissible according to controlling Federal Circuit precedent. As the Federal Circuit stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that "Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 [42 USPQ2d

1378] (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).” Therefore, based on controlling Federal Circuit precedent, the rejection of Claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani is *prima facie* improper, because the rejection is based on improper hindsight.

iv. Because the Rejection of Claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani is *Prima Facie* Improper, this Rejection Should Be Withdrawn.

For at least the reasons discussed above, the Final Office Action has failed to show where all of the features of Claims 7, 9, 14 and 16 are taught or suggested by the combination Asum and Blank and further in view of Kyotani. Also, for at least the reasons discussed above, the combination of Asum with Blank and further in view of Kyotani is *prima facie* improper according to both MPEP § 706.02(j) and controlling Federal Circuit case law. Therefore, the rejection of Claims 7, 9, 14 and 16 over Asum in view of Blank and further in view of Kyotani is *prima facie* improper and should be withdrawn.

F. Failure to Provide Affidavit/Declaration under 37 C.F.R. § 104(d)(2).

In Applicant’s June 5, 2006 Amendment, Applicant properly requested that the Examiner provide an Affidavit/Declaration under 37 C.F.R. § 104(d)(2), because the Examiner rejected Claims 4-16 over Asum in view of Blank and further in view of Kyotani based on facts within the personal knowledge of the Examiner (See Applicant’s June 5, 2006 Amendment, pp. 9-10). However, the Examiner has failed to provide the properly requested Affidavit/Declaration. Therefore, the rejection of Claims 4-16 is *prima facie* improper and should be withdrawn for this additional reason.

G. Request for Affidavit/Declaration under 37 C.F.R. § 104(d)(2).

The Final Office Action made the following allegations at pages 3 and 4 of the Final Office Action:

(3) It is held that the combination of reference is motivated because they all are directed to solving problems with removing material between teeth, and as such, one of ordinary skill in the art would be motivated to combine features such as known locations for abrasives and non-abrasive surfaces. The combination properly shows all of the claimed features. (See Final Office Action, p. 3-4.)

In making Allegation (3), the Final Office Action fails to cite to any references or provide any other factual evidence to support such a conclusory statement. Therefore, the Examiner has relied on facts within his personal knowledge in rejecting Claims 1 and 4–17. In addition, as discussed above, Allegations (1) and (2) are also unsupported by any factual evidence provided by the Examiner. Accordingly, Applicant now requests that the Examiner provide an Affidavit/Declaration under 37 C.F.R. § 104(d)(2) that contains facts supporting the Examiner's unsupported allegation(s), or else withdraw the rejections of Claims 22-32, 34-35 and 51.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark Gutttag at 703-563-2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,

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